

REMARKS

Claims 1 and 9-14 remain pending in this application. Claim 1 is rejected. Claims 2-8 are cancelled herein. New claims 9-14 are added. Claim 1 is amended herein to clarify the invention. Support for the amendment of claim 1 and for new claims 9-14 is found, for example, in the claims as filed, in the specification on page 2, lines 17-20, page 3, lines 12-16, page 5, lines 12-21, page 7, lines 5-6, page 8 lines 18-21, and figures 2A, 3, and 7.

The Abstract of the disclosure has been objected to for having more than 150 words. The Abstract has been amended to have fewer than 150 words. Accordingly, Applicant respectfully requests that the objection to the Abstract be withdrawn.

Claim 5 has been rejected under 35 U.S.C. § 112, second paragraph, as indefinite. The cancellation of claim 5 makes this rejection moot.

Claims 1, 2, and 5 have been rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 4,284,276 (Worst). The cancellation of claims 2 and 5 makes the rejection of claims 2 and 5 moot. To establish a *prima facie* case of obviousness, it is necessary to show that all the claim limitations are taught or suggested by the prior art. *See In re Royka and Martin*, 180 USPQ 580, 583 (CCPA 1974); MPEP § 2143.03. However, the Examiner's rejection fails to fulfill this requirement because Worst fails to teach or suggest a groove

completely circumscribing a golf ball or a groove having a width of 1/3, 1/4, or 1/8 of a diameter of a golf ball, or a groove with a depth of 1/8 of a diameter of a golf ball, as recited in claim 1.

There is no disclosure or suggestion in Worst of having a groove completely circumscribing a golf ball, as recited in claim 1. Furthermore, although the Office Action alleges that Fig. 11 of Worst shows a groove with a width of about 1/4 of the diameter of the golf ball, this is not the case. Also, the Office Action states that it would have been an obvious design choice for a person of ordinary skill in the art to provide any measurement to the groove depth and width because Applicant has not disclosed that the stated measurements “provide an advantage, is used for a particular purpose, or solves a stated problem.” However, the specification of the current application discloses that the groove affects the rolling and motion of a golf ball and that the different widths affect the movement of the golf ball to different degrees and are made for players of different levels of skill, as described on page 2, lines 17-20, and page 5, lines 12-21 of the specification of the current application. The different widths of the groove correspond to different skill levels of golf ball players. Accordingly, claim 1 is patentable over Worst at least because Worst fails to disclose or suggest several limitations of claim 1, as enumerated above.

Claims 9-12 are patentable at least for the reason that they depend from a patentable base claim. *See In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988); MPEP § 2143.03. Also, Worst fails to disclose or suggest at least one selected from a logo, number, symbol, and slogan printed on a groove, as recited in claims 9-14. Thus, claims 9-14 are patentable over Worst. Accordingly, Applicant respectfully requests that the rejection of claim 1 under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 4,284,276 (Worst) be withdrawn and that the patentability of claims 9-14 over Worst be acknowledged.

Claims 3 and 4 have been rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 2,135,210 (Farrar) as described on pages 3-4 of the Office Action. The cancellation of claims 3 and 4 makes the rejection of claims 3 and 4 moot. Claims 9-14 are patentable over Farrar at least for the reason that Farrar fails to disclose or suggest at least one selected from a logo, number, symbol, and slogan printed on a groove, as recited in claims 9-14. Accordingly, Applicant respectfully requests that the patentability of claims 9-14 over Farrar be acknowledged.

In the Office Action, the Examiner acknowledged receiving priority documents but did not check all of the necessary boxes. Applicant respectfully request that the Examiner check all of the necessary boxes.

The USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,
JORDAN AND HAMBURG LLP

By C. Bruce Hamburg
C. Bruce Hamburg
Reg. No. 22,389
Attorney for Applicants

By and,

By Ricardo Unikel
Ricardo Unikel
Reg. No. 52,309
Attorney for Applicants

Jordan and Hamburg LLP
122 East 42nd Street
New York, New York 10168
(212) 986-2340